

A PETITION FOR REVIVAL OF AN ABANDONED PATENT

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 16 June 2005

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 Legal Staff
 International Division
 International Division

United States Patent & Trademark Office
 PCT Mail Stop
 PO Box 1450
 Alexandria, VA 22313-1450

Re: Patent Application 10/509968

Dear Gentlemen:

I am an independent inventor, not employed by any company, nor with any other source of substantial financial resources to help me in my invention work. I have, so far, applied for and received two patents from the USPTO. I also applied for a PCT extension to my latest US patent filing, and when the time came for the deadline to enter the national stage, I submitted the forms and payment required to have that patent application enter the national stage in the US.

I used a patent counsel for the first patent application, but did the second one on my own (with some help from a friend). When it came time to file the PCT extension I was advised to seek professional help and I did so. But when the time came to enter the national stage, I was told I could easily do that myself.

Since I am relatively new to this whole business, and wanting to be sure I did everything right, I decided to seek the help of your PCT help desk staff. I understand that you set up the PCT help desk precisely to serve folks such as I. Unfortunately, the very process that was supposed to help me has, in now has turned out, had almost exactly the opposite effect.

I am writing today in hopes that you can set right a gross injustice that has happened to me, and that was caused in large part by your PCT help staff.

The deadline for me to file to have my patent application enter the national stage in the US was 1 October 2004. A few days before that time I went to the USPTO web site and downloaded your form PTO-1390 (REV. 7-2004), titled "Transmittal letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission under 35 U.S.C. 371."

I studied that form, and since I was somewhat unsure of how to fill it in properly, and what fees I should pay, I decided to call the PCT help desk for help. I tried calling that office many times over several days before I finally got a live person to answer on Thursday, 30 September 2004.

Unfortunately, that person told me that I had reached the right office phone number, but that he couldn't help me as he was only there to answer the phone while all the folks who knew the regulations were moving that office to another location. He was able to assure me that if I filed my application the following day, 1 October 2004, it would be considered a timely filing, and he encouraged me to call back to the PCT help desk the next day.

So I did just that.

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When I called the PCT help desk the next morning, I got a very helpful man (whose name, unfortunately, I don't now recall). He and I spent quite a bit of time going over the form PTO-1390 line by line and, in light of the details of my case as I described it to him, and he then advised me what I should put in each location on that form.

I was particularly concerned about the proper amount to pay with this application, and he assured me that the correct amount was \$365.00, as I am clearly a "small entity" and I filed an amendment with my application to reduce the number of claims to just three, all of which were (as amended) in the form approved by the USPTO examiner in his preliminary international examination report.

As soon as I got off the phone, I filled in the form in exactly the manner he had advised, and then submitted it to the USPTO by priority mail. This mailing included a copy of your form PTO-2038 to authorize you to charge my credit card \$365.00 to cover the fee listed on form PTO-1390.

A side note: The reason I had amended my application to reduce the number of claims to three is that the same examiner who examined my domestic patent application had done the preliminary examination of the PCT filing, and he had found just three of my claims, once suitably amended) would meet the standards of novelty and usefulness, so I anticipated that since I had withdrawn all the other claims (and amended the remaining ones per his suggestions) this PCT national stage application would sail through the process relatively free of problems, other than the long delays that are typical these days.

About a week later I found that my credit card company had processed a charge by the USPTO for \$365.00, and shortly thereafter I received the postcard receipt indicating the number assigned to this application (and, I presumed, verifying that all the pieces were in place and, I supposed, that the fee I had submitted was deemed to be the proper amount).

So it was with a great deal of horror and shock that six months later I received a letter from a Ms. Francine Young in your office stating that my application had been abandoned because I had failed to provide the proper fee. How could this be?!

Naturally, I called her as soon as I got the letter. It took me several tries, and nearly a week, but eventually I got to talk to her. And, at first, she didn't know what had happened either.

After she got a copy of the full file and studied it, she was able to tell me that apparently what happened was that I relied upon a USPTO representative on the PCT help desk who, as it turned out, gave me bad advice. He (and I) didn't realize that on October first a new fee schedule went into effect. I had, as it turns out, underpaid the fee by \$110.00, according to Ms. Young.

She further explained that if only I had had a deposit account, they would simply have deducted that additional amount from that account. This procedure clearly handles your larger customers very nicely. But it doesn't help at all for those of us who are "small fry" independent inventors, as my level of business with the USPTO has been so small that having and funding a deposit account makes little sense. (Or at least, so I thought until this episode.)

Why wasn't I informed of the shortfall immediately after my filing? Apparently as soon as the shortfall was detected, if I had had a deposit account, that account would have been debited. Why not at that point, since I didn't (and don't) have a deposit account, simply notify me and ask for an authorization to charge my credit card the necessary \$110.00 (or whatever was the correct amount)? [Actually, you could simply have charged it to my credit card without any further

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authorization—as was proven when a spurious \$65.00 was charged by the USPTO for reasons I have yet to learn, and then reversed, just over a month ago. Naturally, this isn't quite kosher, but it did and does work, and you could seek a legal authorization for it later on, if you had a need to record that payment before you could obtain the authorization.]

When I got the letter from Ms. Young, I went back to the USPTO web site and downloaded a fresh copy of the form PTO-1390. This one says it was revised in February, 2005. The form I got from your web site late last September had been revised in July, less than three months previously, and there was no indication on that web page that it would become invalid just a couple of days later—and the PCT help desk person evidently had pulled up the same form on Friday, October first, so he could walk me through it. And from the revision date on the current form it would appear that anyone downloading the form between October 1st and some date in February might well have gotten the same, after-October-first-out-of-date form that I used.

When I examined the fees listed on the new PTO-1390, and thought about what had already happened in this case, I think possibly Ms. Young overstated my underpayment. Specifically, my PCT application specified the EPO as the international search agency, and I provided the examiner of my domestic patent application (on which this PCT application was based) with a copy of that report last September. Further, the examiner of my domestic patent application did a preliminary examination of my PCT application and provided me with a copy of that last fall. I believe that the fee for that preliminary examination was paid prior to his doing that examination—a matter that was handled for me by my international patent counsel some time last year.

So, if I understand the items 21 through 23 correctly on the new PTO-1390, the proper fee for me to pay at this time in my situation would be the following:

Line 21: \$300.00 (basic national fee)

Line 22: \$100.00 (since examiner said in his preliminary examination report that all the claims I left in my national stage application were allowable)

Line 23: \$400.00 (since the international search was done by the EPO and I provided a copy of their report previously).

All of which leads to a total of \$800.00 for large entities, and for a small entity only \$400.00. **Thus, my payment of \$365.00 was, if I am correct in these calculations, only \$35.00 less than it should have been!**

Ms. Young has explained to me that you can reverse the abandonment and reinstate my patent as if this whole mess had not occurred, but she said I would have to pay not only the \$110.00 by which she said I had underpaid last fall, but also an added fee of \$750.00 just to get you to consider my case. This seems to me, to say the least, highly punitive and a rather gross injustice, since only small, independent inventors who lack a deposit account would ever be assessed this huge penalty.

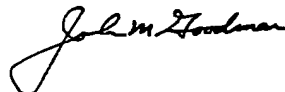
So, I am enclosing with this letter a copy of my original PTO-1390 form, a copy of the form PTO/SB/01 that had accompanied it, and two copies of the new form PTO-2038, one authorizing you to charge my credit card up to \$110.00; and the other authorizing you to charge my credit card (if you must) the punitive \$750.00 fee to consider this request to reverse the abandonment of my patent application.

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However, I respectfully request that you waive the latter fee, given that my error was caused very directly by bad advice by a member of your staff, **and only charge my credit card the missing \$35.00 or \$110.00**, whichever you determine is the correct amount of my fee shortfall last fall.

Thank you for considering my request, and for reversing the abandonment of my national stage patent application.

Sincerely yours,



John M. Goodman, Ph.D.

Enc.

cc: The Honorable Loretta Sanchez
Congresswoman for the 47th District of the State of California



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 15 2005

The Honorable Loretta Sanchez
U.S. House of Representatives
12397 Lewis Street, Suite 101
Garden Grove, CA 92840

Attention: William Ray

Dear Representative Sanchez:

Thank you for your letter on behalf of Mr. John M. Goodman regarding the abandonment of his US national stage application serial number 10/509,968. We appreciate hearing from you.

Our Office of PCT Legal Administration has reviewed the file contents of US national stage application serial number 10/509,968. It has been determined that the notification of abandonment that was mailed to Mr. Goodman on April 15, 2005, was proper. The basic national fee for a small entity under 37 CFR 1.492(a) that was in effect as of October 1, 2005, for an international application in which the preliminary examination fee was paid to the United States Patent and Trademark Office (USPTO), was \$375. Since the credit card authorization filed with the papers for entry into the US national stage on October 1, 2004, was only for \$365, the fee payment was deficient by \$10.

The U.S. statute in conjunction with the Patent Cooperation Treaty (PCT) requires the national fee to be paid by 30 months from the priority date in order to avoid abandonment of the application. In this application, the 30-month time period for entry into the US national stage expired at midnight on October 1, 2004. Unfortunately, in this case, the \$375 national fee was not paid in full by midnight on October 1, 2004. Thus, this national stage application became abandoned. The USPTO has no authority to waive any provisions of the U.S. statute or PCT Regulations. Furthermore, it should be noted that the USPTO cannot make any additional charges to a credit card over and above the amount authorized by the applicant in a credit card authorization. See 37 CFR 1.23(b).

We deeply regret any misleading information Mr. Goodman may have received from the PCT Help Desk regarding the amount of fees due. The Office of PCT Legal Administration, the area of the USPTO that administers the PCT Help Desk, moved its offices from Arlington, Virginia, to Alexandria, Virginia, on the very day that Mr. Goodman called the PCT Help Desk, September 30, 2004. As a result, on that day, the Help Desk staff was forced to access the Help Desk from a remote location until the Help Desk could be set up in the new Alexandria office the

next day. Unfortunately, the informational resources available to the Help Desk staff at that remote location were limited. We truly regret any misleading information that may have been given on that day.

If Mr. Goodman wishes to pursue prosecution of this US national stage application before the USPTO, he has the option of filing a petition to revive this US national stage application under section 1.137 of title 37 of the *Code of Federal Regulations*. These regulations are available on the USPTO's web site at www.uspto.gov. Rest assured that any petition filed by Mr. Goodman will be given full and careful consideration. Mr. Goodman may also find it helpful to visit the website for our Office of PCT Legal Administration, www.uspto.gov/go/pct, for current information on filing any additional papers and fees in this US national stage application.

Although inventors may file and prosecute their own patent applications without representation by counsel, the USPTO encourages applicants to seek the advice and services of a registered patent attorney or agent since prosecution of a patent application can be confusing and complex, especially to persons who are unfamiliar with the relevant laws and regulations. Our Office cannot recommend or aid in the selection of an attorney or agent. However, a listing of registered attorneys and agents is available on the USPTO web site.

We trust the foregoing will be useful in responding to your constituent.

Sincerely,

A handwritten signature in dark ink, appearing to read 'C. Katapis', followed by a horizontal line.

Chris J. Katapis
Director of Congressional Relations

Drafted by D.Oleksa / C.Pearson/PCT
Edited by J.Cooksey/7/13/2005
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C : Under Sec. / Cong.Lia.